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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,046	04/21/2005	Hiromune Ozaki	SAEG173.001APC	3156
20995 7590 09/11/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER NICKERSON, JEFFREY L.				
ART UNIT 2142		PAPER NUMBER		
NOTIFICATION DATE 09/11/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/509,046

Applicant(s)

OZAKI, HIROMUNE

Examiner

JEFFREY NICKERSON

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This communication is in response to Application No. 10/509,046 filed nationally on 21 April 2005 and internationally on 11 March 2003. The request for continued examination presented on 16 July 2008, which provides change to claims 1, 7-8, the abstract, and adds claims 9-17, is hereby acknowledged. Claims 1-17 have been examined.

Specification

2. The RCE presented on 16 July 2008 providing change to the abstract is noted. All outstanding objections to the abstract are hereby withdrawn.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). See the rejection based on 35 U.S.C. 112, first paragraph, below.

Response to Arguments

3. Applicant's arguments, filed 16 July 2008, with respect to the rejection(s) of claim(s) 1, 7, and 8 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9, 12, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 9, 12, and 15, these claims contain the following limitation: "*wherein a Web site containing the Web page is not owned by the registered user*". Applicant alleges that support for this newly added claim can be found in paragraph [0036]. However, applicant's submitted specification does not have paragraph numbers. Therefore, the examiner can only assume that the paragraph number being referred to is from the application's Pre-Grant Publication, US 2005/0188017 A1. Paragraph [0036] of the PGPub states:

When a registered user attempts to access a Web page, the Web page transmitter 14 transmits the Web page for the specified URL to the user terminal 4 (Step S2), as a result of which a portal page as shown in FIG. 4 is displayed on the user terminal 4.

This paragraph states nothing about ownership of the Web page and therefore the examiner respectfully disagrees with this paragraph supporting the aforementioned limitation. The examiner further conducted a text search of the applicant's specification for the term "own" and any partial variants. The examiner could not find support for the

forementioned limitation, specifically the part regarding ownership, anywhere in the applicant's specification. Therefore, this claim introduces new matter into the applicant's original disclosure and is not compliant with 35 USC 112 1st paragraph.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-10, 12-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller (US 6167435), and in further view of Murray (US 2002/0094870 A1) and Mullaney (US 2001/0037283 A1).

Regarding claim 1, Druckenmiller teaches a method for distributing information (informational messages) to multiple users via a network (Druckenmiller: col 2, lines 58-65 specify multiple subscribers connected to the distribution server over a network), the method comprising the steps of:

transmitting, at a server, notice information (emails, messages, specifically verification emails) to a destination email address of a registered user (subscriber) whose user information, including a unique user ID (unique token) and the destination email address, has been stored, the notice information containing the user ID

(Druckenmiller: col 4, lines 30-56 specify that the subscribers register for mailing lists which are distributed to their email address via email notices; Druckenmiller: col 4, line 58 – col 5, line 11 specify associating a token with the subscriber and their email address and storing the user information in a database and sending notice information containing the user token);

acquiring the user ID of the registered user and transmitting a designated Web page when the registered user clicks a banner area (link) that is displayed on the user terminal by receiving the notice information (Druckenmiller: col 5, lines 16-33 specify that one embodiment involves returning the token by clicking a URL and filling a form, which provides sending a web page to the user terminal; See also Figure 3, items 38, 32, 34);

transmitting the notice information to an email address (Druckenmiller: col 4, lines 30-67 being sent a verification email containing a unique token);

acquiring the user ID of the registered user and transmitting the Web page when a user clicks a banner area that is displayed on the user terminal by receiving the notice information (Druckenmiller: col 5, lines 16-33 specify that one embodiment involves returning the token by clicking a URL and filling a form, which provides sending a web page to the user terminal; See also Figure 3, items 38, 32, 34); and

wherein notice information contains a unique user ID (Druckenmiller: col 4, line 58 – col 5, line 11 specify sending notice information containing the user token).

Druckenmiller does not teach:

receiving, at the server, from the registered user, a request for forwarding notice information to a forwarding address of an unregistered user, the forwarding address being provided by the registered user via a Web page;

wherein transmitting notice information is to the forwarding address;

wherein the user ID of the registered user is acquired when an unregistered user registers;

issuing a new user ID that is associated with the user ID of the registered user when a request for registration is made by the unregistered user via the Web page; and
storing user information, including the new user ID and the forwarding address.

Murray, in a similar field of endeavor, teaches:

receiving, at the server, from the registered user, a request for forwarding notice information to a forwarding address of an unregistered user (Murray: [0066]-[0069]);

wherein the registered user is registered at the server and has the unique user ID issued by the server, and wherein the unregistered user is not registered at the server and does not have a unique user ID issued by the server (Murray: [0069]-[0075]);

wherein transmitting notice information is to the forwarding address (Murray: [0075]);

wherein the user ID of the registered user is acquired when an unregistered user registers (Murray: [0075]-[0082]);

issuing a new user ID that is associated with the user ID of the registered user when a request for registration is made by the unregistered user via the Web page (Murray: [0075]-[0082]); and

storing user information, including the new user ID and the forwarding address (Murray: [0075]-[0082]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Murray for allowing registered users to propagate information to their contacts via electronic communication. The teachings of Murray, when implemented in the Druckenmiller system, will enable one of ordinary skill in the art to increase the advertisement distribution database by viral marketing. One of ordinary skill in the art would be motivated to utilize the teachings of Murray in the Druckenmiller system in order to accumulate subscribers and get subscribers to view advertisements.

The Druckenmiller/Murray system does not teach wherein the forwarding address is provided by the registered user via the Web page.

Mullaney, in a similar field of endeavor, teaches wherein the forwarding address is provided by the registered user via the Web page (Mullaney: Figure 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Mullaney for allowing registered users enter information via a web page. The teachings of Mullaney, when implemented in the Druckenmiller/Murray system, will enable one of ordinary skill in the art to have the advertising/email server send the emails rather than let the team captain start sending them. One of ordinary skill in the art would be motivated to utilize the teachings of Mullaney in the Druckenmiller/Murray system in order to harvest email addresses from the referrer rather than waiting for the referred to receive the email and register/enroll.

Regarding claim 2, the Druckenmiller/Murray/Mullaney system teaches wherein the notice information transmitted by the server to the registered or unregistered user contains information indicating the location of the Web page and being accompanied by the user ID (Druckenmiller: Figure 3, item 38 depicts the URL which is a location of a Web page; Figure 3, item 32 depicts the user's email address which is used as an identifier; Figure 3, item 34 depicts the user's token ID, another user ID).

Regarding claim 3, the Druckenmiller/Murray/Mullaney system teaches wherein the notice information transmitted by the server to the forwarding address includes comment data received from the registered user (Mullaney: Figure 4, bottom right of section 62 depicts a comment box to be included to email messages to friends).

Regarding claim 5, the Druckenmiller/Murray/Mullaney system teaches wherein the email addresses to which notice information cannot be sent include the email addresses of unregistered users who have sent a notice to the effect that they do not wish to receive the notice information (Druckenmiller: col 7 line 55 – col 8, line 8 specify how users can unsubscribe from a mailing list).

Regarding claim 6, the Druckenmiller/Murray/Mullaney system teaches wherein the notice information is transmitted via email (Druckenmiller: col 9, lines 49-56 specify the

various mediums this invention can occur on, including the preferred embodiment of email).

Regarding claim 7, this server claim contains limitations corresponding to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 8, this computer readable medium claim contains limitations corresponding to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 9, the Druckenmiller/Murray/Mullaney system teaches wherein the notice information comprises a link to a Web page, and wherein a Web site containing the Web page is not owned by the registered user (Murray: [0075] specifies the enrolling user is directed to the sponsor's site).

Regarding claim 10, the Druckenmiller/Murray/Mullaney system teaches wherein the notice information comprises a link to the Web page (Murray: [0075]); wherein the Web page comprises electronic information which can be subscribed (Druckenmiller: Figure 3); and wherein the subscribable electronic information is distributed to a plurality of unregistered users by registering the plurality of unregistered users at the server in a successive way (Druckenmiller: Figure 3 for subscription based distribution; Murray: [0070]-[0075] for successive registration of unregistered users).

Regarding claim 12, this server claim contains limitations corresponding to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 13, this server claim contains limitations corresponding to that of claim 10 and the same rationale of rejection is used, where applicable.

Regarding claim 15, this computer readable medium claim contains limitations corresponding to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 16, this computer readable medium claim contains limitations corresponding to that of claim 10 and the same rationale of rejection is used, where applicable.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller (US 6167435), in view of Murray (US 2002/0094870 A1) and Mullaney (US 2001/0037283 A1), and in further view of Ferber (US 7,184,971 B1).

Regarding claim 4, the Druckenmiller/Murray/Mullaney system does not teach:

wherein the notice information is transmitted by the server to addresses selected from multiple forwarding addresses specified by the registered user by eliminating those stored as ones to which notice information cannot be sent.

Ferber, in a similar field of endeavor, teaches wherein the notice information transmitted by the server to the addresses selected from multiple forwarding addresses specified by the registered user lists eliminating those stored as ones to which notice information cannot be sent (Ferber: col 3, lines 35-36 specify the system removes undeliverable email addresses; See also col 2, lines 19-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Ferber for removing bogus email addresses. The teachings of Ferber, when implemented in the Druckenmiller/Murray/Mullaney system, will allow one of ordinary skill in the art to forward emails to unregistered users that do not have bogus email addresses. One of ordinary skill in the art would be motivated to utilize the teachings of Ferber in the Druckenmiller/Murray/Mullaney system in order to reduce unnecessary email traffic and protect against nefarious forwarding users.

9. Claims 11, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller (US 6167435), and in view of Murray (US 2002/0094870 A1) and Mullaney (US 2001/0037283 A1), and in further view of Official Notice.

Regarding claim 11, the Druckenmiller/Murray/Mullaney system does not teach wherein the subscribable electronic information is an electronic magazine.

An official notice is taken that such use of electronic magazines as a type of subscribable electronic information was well known in the art at the time the invention was made by one of ordinary skill in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize any known subscribable electronic information type including electronic magazines because it would have enabled practicing the the Druckenmiller/Murray/Mullaney system.

Regarding claims 14 and 17, these claims contain limitations corresponding to that of claim 11 and the same rationale of rejection is used, where applicable.

Cited Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Cantrell (US 2002/0103698 A1) discloses a viral marketing email system.
 - b. Costin, IV et al (US 2002/0049816 A1) discloses a viral marketing email system for raising funds.
 - c. Ross, JR. (US 2002/0143885 A1) discloses viral marketing email system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. N./
Jeffrey Nickerson
Examiner, Art Unit 2142

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142